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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/498,856	02/04/2000	Hiroshi Ohnishi	381TO/41092CO	9387

7590 06/18/2002

Crowell & Moring LLP  
Intellectual Property Group  
PO Box 14300  
Washington, DC 20044-4300

EXAMINER

ZANELLI, MICHAEL J

ART UNIT	PAPER NUMBER
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3661

DATE MAILED: 06/18/2002

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Paper No. 18

Application Number: 09/498,856  
Filing Date: February 04, 2000  
Appellant(s): OHNISHI ET AL.

**MAILED**

JUN 18 2002

**GROUP 3600**

Gary R. Edwards  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 4/15/02.

**(1) *Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

**(2) *Related Appeals and Interferences***

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Applicant filed an updated statement on 4/15/02, paper no. 17 which identifies appealed co-pending reissue parent application 09/064765.

**(3) *Status of Claims***

The statement of the status of the claims contained in the brief is correct.

**(4) *Status of Amendments After Final***

No amendment after final has been filed.

**(5) *Summary of Invention***

The summary of invention contained in the brief is correct.

**(6) *Issues***

The appellant's statement of the issues in the brief is correct.

**(7) *Grouping of Claims***

The rejection of claims 12-14 stand or fall together as stated in the brief.

**(8) *Claims Appealed***

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(9) *Prior Art of Record***

No prior art is relied upon by the examiner in the rejection of the claims under appeal.

**(10) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claims 12-14 stand rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

A. As per reissue claims 12-14, the claims are directed to a control system for an automatic transmission with a torque converter including a control unit for controlling the transmission using an estimated torque value. Patented claims 1, 2, 4, 5, 6, and 7 are directed to a system and method for controlling selection of a gear position for an automatic transmission. Further, the patented claims include weight estimation means, acceleration input means, output torque estimation means, running load means, memory means, shift schedule unit, and gear shift determination means. The reissue claims merely include first and second input torque estimating units, selecting unit, and a control unit. Reissue claim 14 also includes

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a storing unit and a calculation unit. Thus, the reissue claims are broader in at least some aspects relative to the patented claims.

B. Since broader aspects have been shown, one looks to see if the broader aspects relate to surrendered subject matter; specifically, prosecution history. The exact language of the patented claims noted in the Reasons for Allowance does not appear anywhere in the reissue claims. The particular situation here corresponds to Example C described in MPEP 1412.02:

*"If the limitation now being omitted or broadened in the present reissue was originally presented/argued/stated in the original application to make the claims allowable over a rejection or objection made in the original application, the omitted limitation relates to subject matter previously surrendered by applicant, and impermissible recapture exists."*

*"The limitation omitted in the reissue claims was present in the claims of the original application. The examiner's reasons for allowance in the original application stated that it was that limitation which distinguished over a potential combination of references X and Y. Applicant did not present on the record a counter statement or comment as to the examiner's reasons for allowance, and permitted the claims to issue. The omitted limitation is thus established as relating to subject matter previously surrendered."*

C. For example, reissue claim 12 at a minimum must include the preamble, output torque estimation means, and wherein clause of patent claim 1 (original application claim 5) because the Reasons for Allowance specifically states:

*"Claims 5 ... allowable because the combination of the means/step for estimating the output torque by one of two alternative methods are respectively recited in the claims, depending on whether the ratio between the input and output speeds of the torque converter is greater than a predetermined value, with the other limitations of the respective claims is deemed to have not been taught by the cited prior art".*

Since applicant did not present on the record a counter statement or comment as to the examiner's reasons for allowance, and permitted the claims to issue, the omitted limitation(s) is thus established as relating to subject matter previously surrendered.

**(11) Response to Argument**

A. Appellant argues that claims 12-14 are concerned with "input" torque not "output" torque as set forth in the patented claims. First, the term "input" torque is not explicitly used anywhere in the written description and thus the term itself is open to interpretation. However, one of ordinary skill in the art at the time of invention would have recognized that the terms "input" and "output" are relative in nature. For example, the output torque of the engine could also be referred to as the input torque of the torque converter. Both the reissue claims and the patent claims (i.e., at least claim 1) read on Fig. 10. The examiner disagrees that the reissue claims and patent claims are so distinct that the recapture issue is not even raised. To the contrary, claims 12-14 appear to be directed to subject matter included within the scope of the "output torque estimation means". Col. 7, line 13 to col. 8, line 7 describes the manner in which the output torque is estimated whereby the "input" torques now claimed appear to be a subset of or included in the overall structure of the output torque

estimation means. Thus, the newly claimed subject matter is broader than the “output torque estimation means” limitation for which the examiner indicated as being the basis for allowing patent claim 1 to issue.

B. Appellant alleges examiner’s correlation of input/output torque is incorrect because the output torque and the input torque of an automatic transmission are basically different and goes on to explain gear ratios. The examiner totally agrees with appellant’s explanation of the relationship between input and output torque of an automatic transmission. **However**, that is not what the examiner stated in the final rejection or as repeated above in paragraph A. The examiner stated that the *output* torque of the *engine* could also be referred to as the *input* torque of the *torque converter*. Thus, appellant’s argument in this regard is irrelevant.



C. With regards to appellant’s arguments as to which elements of Figure 10 the claims correspond to, patented claim 1 (original patent application claim 5) was allowed by the examiner based on subject matter included in the wherein clause. The wherein clause describes subject matter related to the structures within element 108, not 110. By appellant’s own admission reissue claims 12-14 read on element 108. Thus, appellant is attempting to

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broaden the subject matter of the patented invention by eviscerating part of element 108 without the specific combination of elements noted in the examiner's reason for allowance.


For the above reasons, it is believed that the rejections should be sustained.


Respectfully submitted,

/mjz  
June 13, 2002

  
**MICHAEL J. ZANELLI**  
**PRIMARY EXAMINER**

Conferees:

William Cuchlinski, SPE 3661 

Gary Chin, Primary Ex. 3661 

Crowell & Moring LLP  
Intellectual Property Group  
PO Box 14300  
Washington, DC 20044-4300